

Appl. No. 10/063,401  
Docket No. G1/N-0297 / 41/R-7838

### REMARKS / ARGUMENTS

#### Status of Claims

Claims 1-41 are pending in the application. Claims 3, 5, 8, 16, 17, 20-22, 25, 33, 34 and 36 are withdrawn. Claims 1, 2, 4, 6, 7, 9-15, 18, 19, 23, 24, 26-32, 35 and 37-41 stand rejected. Applicant has amended Claims 1, 10, 18, 39 and 41, canceled Claims 3, 5, 8, 16, 17, 20-22, 25, 33-38, and added new Claims 42-46, leaving Claims 1, 2, 4, 6, 7, 9-15, 18, 19, 23, 24, 26-32 and 39-46 for consideration upon entry of the present Amendment.

Applicant respectfully submits that the rejections under 35 U.S.C. §102(b) and 35 U.S.C. §103(a) have been traversed, that no new matter has been entered, and that the application is in condition for allowance.

#### Rejections Under 35 U.S.C. §102(b)

Claims 1-2, 4, 6-7, 9, 18-19, 23-24, 26 and 35 stand rejected under 35 U.S.C. §102(b) as being anticipated by Mrenna et al. (U.S. Patent No. 4,719,438, hereinafter Mrenna).

Applicant traverses this rejection for the following reasons.

Applicant respectfully submits that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, *in a single prior art reference.*" *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the \*\*\* claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Furthermore, the single source must disclose all of the claimed elements "arranged as in the claim." *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984). Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference.

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Titanium Metals Corp. v. Banner, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985).

Applicant has amended independent Claims 1 and 18 to include "a first magnet yoke disposed proximate to said first electrically conductive strap, *said first magnet yoke comprising inwardly extended flanges defining a gap "z" therebetween*". Support for this amendment may be found in the specification as originally filed and more specifically in Claims 10 and 27 as originally filed. No new matter has been added. Dependent claims inherit all of the limitations of the respective parent claim.

The Examiner acknowledges that Mrenna does not disclose the elements of Claims 10, 27 and 39 that include elements for the yoke further including a U-shaped yoke piece having a pair of flanges extending from opposite ends of the U-shaped bight and a gap between the flanges to the armature. Paper 12405, page 3.

In comparing Mrenna to the instant invention, and in view of the Examiner's assessment of Mrenna, Applicant submits that Mrenna does not disclose "...a first magnet yoke disposed proximate to said first electrically conductive strap, *said first magnet yoke comprising inwardly extended flanges defining a gap "z" therebetween*; and a first armature pivotally disposed proximate to and adjustable to define a first and a second distance "T" *from said inwardly extended flanges of said first magnetic yoke...*"

Absent anticipatory disclosure in Mrenna of each and every element of the claimed invention arranged as in the claim, Mrenna cannot be anticipatory.

In view of the amendment and foregoing remarks, Applicant submits that the Mrenna does not disclose each and every element of the claimed invention arranged as claimed and therefore cannot be anticipatory. Accordingly, Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. §102(b) has been traversed, and requests that the Examiner reconsider and withdraw of this rejection.

#### Rejections Under 35 U.S.C. §103(a)

Claims 10-14, 27-31 and 37-41 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Mrenna in view of Montague et al. (U.S. Patent No. 5,670,922,

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hereinafter Montague) or Dachler et al. (U.S. Patent Publication No. 2003/0174033, hereinafter Dachler).

Regarding Claims 10, 27 and 39, the Examiner acknowledges that Mrenna does not disclose the yoke further including a u-shaped yoke piece having a pair of flanges extending from opposite ends of the u-shaped bight and a gap between the flanges to the armature, and looks to either Montague or Dachler to cure this deficiency. Paper 12405, page 3.

Claims 15 and 32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Mrenna in view of Arnold et al. (U.S. Patent No. 5,381,120, hereinafter Arnold).

Regarding Claims 15 and 32, the Examiner acknowledges that Mrenna does not disclose the armature being attached to the conductive strap, and looks to Arnold to cure this deficiency.

Applicant hereinafter refers to Mrenna and Montague, or Mrenna and Dachler, or Mrenna and Arnold, collectively as the References.

Applicant traverses these rejections for the following reasons.

Applicant respectfully submits that the obviousness rejection based on the References is improper as the References fail to teach or suggest each and every element of the instant invention. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Examiner must meet the burden of establishing that all elements of the invention are taught or suggested in the prior art. MPEP §2143.03.

Applicant has amended Claims 1, 18, and 39, to now recite, inter alia:

***"...wherein in response to a first current through said strap being about 3 times a rated current of the circuit breaker, and said first distance "L" being less than said gap "z", a first magnetic torque is developed at said first armature;***

***wherein in response to said first current through said strap, and said second distance "L" being greater than said gap "z", a second magnetic torque is developed at said first armature; and***

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*wherein said first magnetic torque is equal to or greater than about 3 times said second magnetic torque."*

Support for these claim amendments may be found in the specification as originally filed at Paragraphs [0023-0026] and [0030-0031], and at Figure 6. No new matter has been added.

At Paragraph [0007], Applicant describes a problem and solution that is recognized and addressed only by the claimed invention, which is more particularly described as a magnetic trip unit that has increased induced magnet trip force at a low trip current threshold without substantially altering the induced magnetic trip force at a high trip current threshold.

At Figure 6, Applicant illustrates the operational characteristics of the claimed structure. In Figure 6, the left end of each curve 74, 76, and 78 represents the operational characteristic of a claimed structural relationship where distance "L" is less than gap "z", and the right end of each curve represents the operational characteristic of a claimed structural relationship where distance "L" is greater than gap "z". For purposes of comparison, curves 84, 86 and 88 are presented as representing operational characteristics of a structure absent the benefit of the instant invention. See also the description of Figure 6 at Paragraph [0030].

Here, Applicant claims a particular configuration of magnet yoke and magnet armature that has a particular operational characteristic because of its structure.

In comparing the References with the instant invention, Applicant submits that the References fail to teach or suggest a magnetic trip unit structure "...wherein in response to a first current through said strap being about 3 times a rated current of the circuit breaker, and said first distance "L" being less than said gap "z", a first magnetic torque is developed at said first armature; wherein in response to said first current through said strap, and said second distance "L" being greater than said gap "z", a second magnetic torque is developed at said first armature; and wherein said first magnetic torque is equal to or greater than about 3 times said second magnetic torque."

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In view of the foregoing, Applicant submits that the References fail to teach or suggest each and every element of the claimed invention, fail to recognize a problem recognized and solved only by the present invention, and disclose substantially different inventions from the claimed invention, and therefore cannot properly be used to establish a prima facie case of obviousness. Accordingly, Applicant respectfully requests reconsideration and withdrawal of all rejections under 35 U.S.C. §103(a), which Applicant respectfully submits have been traversed.

Furthermore, Applicant respectfully submits that an Examiner cannot establish obviousness by locating references which describe various aspects of a patent Applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent Applicant has done. *Ex parte Levengood*, 28, USPQ2d 1300, 1302 (Bd.Pat.App.Int., 1993). References may not be combined indiscriminately. It is not enough for a valid rejection to view the prior art in retrospect once an Applicant's disclosure is known. The art applied should be viewed by itself to see if it fairly disclosed doing what an Applicant has done. *In re Skoll*, 187 USPQ 481, 484 (CCPA, 1975) (citing *In re Schaffer*, 108 USPQ 326, 328-29 (CCPA, 1956)). "The test for an implicit showing [of obviousness] is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved *as a whole* would have suggested to those of ordinary skill in the art." (Emphasis added). *In re Kotzab*, 217 F.3d 13645, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

As previously discussed, Applicant has recognized a problem and has provided a solution therefore where a magnetic trip unit provides increased induced magnet trip force at a low trip current threshold without substantially altering the induced magnetic trip force at a high trip current threshold.

In comparing the References with the instant invention, Applicant finds no teaching of this problem and solution, and therefore finds no motivating force to combine the References as suggested by the Examiner to arrive at the claimed invention.

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In view of the foregoing, Applicant submits that no motivation can be found in the References to combine the technologies of the References to arrive at the claimed invention, and that the Examiner has improperly combined the References since there is no evidence of a motivating force that would impel one skilled in the art to do what the patent Applicant has done. Accordingly, Applicant respectfully requests reconsideration and withdrawal of these rejections.

In light of the foregoing, Applicant respectfully submits that the Examiner's rejections under 35 U.S.C. §102(b) and 35 U.S.C. §103(a) have been traversed, and respectfully request that the Examiner reconsider and withdraw these rejections.

**Regarding New Claims 45-46**

Applicant has added new Claims 45-46, which describe the subject matter regarded as the invention in alternative language. Support for Claims 45-46 may be found in the specification, drawings and claims as originally filed. No new matter has been added.

In view of the previous discussion relating to the pending claims, Applicant respectfully submits that the References do not disclose, teach or suggest the claimed invention, and do not motivate one to arrive at the claimed invention.

Accordingly, Applicant submits that new Claims 45-46 are directed to allowable subject and respectfully requests entry and notice of allowance thereof.

The Commissioner is hereby authorized to charge any additional fees that may be required for this amendment, or credit any overpayment, to Deposit Account No. 06-1130.

In the event that an extension of time is required, or may be required in addition to that requested in a petition for extension of time, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is

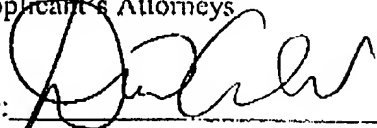
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hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above identified Deposit Account.

Respectfully submitted,

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